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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,626	11/16/2001	Mu-III Lim	CP-1216	3176

27752 7590 02/26/2003

THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
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EXAMINER

ELHILO, EISA B

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 02/26/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/990,626

Applicant(s)

LIM ET AL.

Examiner

Eisa B Elhilo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Claims 1-22 are pending in this application.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-6, drawn to a chemical compound, classified in class 564, subclass 26.
 - II. Claims 7-10, drawn to a process for the preparation of a compound, classified in class 564, subclass 57.
 - III. Claims 11-22, drawn to a hair dyeing composition and method for dyeing hair comprising that dyeing composition, classified in class 8, subclass 405.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions. Invention I is related to the process of making a chemical compound and Invention III is related to the process for dyeing hair that required an oxidizing agents and oxidation bases that not required by Invention I. Therefore, the inventions are not related.
3. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group III, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Charles Zeller on February 13, 2003 a provisional election was made without traverse to prosecute the invention of III, claims 11-22. Affirmation

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of this election must be made by applicant in replying to this Office action. Claims 7-10 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 103

5 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alain et al. (WO 99/48856).

Alain (WO' 856) teaches a hair dyeing composition comprising a compound having a formula (I), which is similar to the claimed formula (I), when in the reference's formula (I), R₂ is C₁-C₆ alkyl radical, R₁ and R₃ are hydrogen atoms, A₁ is a hydroxyl radical, A₂ represents a group NR₄'R'₅ wherein R'₄ is a hydrogen atom and R'₅ is a Z group of the formula (II) in which x = 0, B is a linker arm represents a linear alkyl group containing 1 to 14 carbon atom, and B is attached directly to the N atom, R₇, R₈ and R₉ are alkyl groups and may form together with the nitrogen atom to which they are attached, a 5-or 6-membered saturated carbon atom such as piperidine ring and X- represents a monovalent or divalent anion such as chloride radical (see page 3, formula (I) and lines 20-28, page 4, lines 1-31, page 5, lines 1-30 and page 6, formula (II)), and when in the claimed formula (I) R³ is methyl group, R¹, R and R² are alkyl groups or two of R, R¹ and R² together with the nitrogen atom to which they are attached form a C₃ to C₆ aromatic group and X- is halogen atom such as chloride ion. The composition also comprises

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oxidizing agents such as hydrogen peroxide (see page, 19, lines 13), oxidation bases such as paraphenylenediamines (see page 14, line 10) and other couplers such as 1,3-dihydroxy benzene (see page 15, line 30). Alain also teaches a method for dyeing hair which is similar to the claimed method. The method comprising applying to the hair a dyeing composition as described above and left in place for 3 to 50 minutes after which the hair is rinsed, washed with shampoo, rinsed again and dried (see page 18, lines 25-25 and page 19, lines 1-8).

The instant claims differ from the reference by reciting a dyeing composition comprising a compound of the claimed formula (I), which is specific species and a more limited genus than the reference.

However, it would have been obvious to one having ordinary skill in the art at the time of invention to select any of the species of the genus taught by reference, including those of the claims, because an ordinary artisan would have the reasonable expectation that any of the species of the genus would have similar properties and thus, the same use as the genus as a whole.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B Elhilo whose telephone number is (703) 305-0217. The examiner can normally be reached on M - F (7:30-5:00) with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (703) 308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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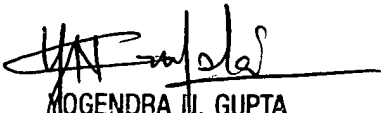
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Elhilo

February 24, 2003



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